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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,996	01/25/2001	Seung-Hyun Nahm	5000-1-156	5422

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CHA & REITER, LLC  
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PARAMUS, NJ 07652

EXAMINER
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MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
2686	10

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/769,996

Applicant(s)

ENJI HATAZAWA

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2686

**DETAILED ACTION**

1. Translation of priority documents over comes previous final action.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-13**, are rejected under 35 U.S.C. 102(b) as being anticipated by Coad et al.(Patent Number 5,966,652).

Regarding **claims 1-2, 9**, Coad teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 3 lines 15-21), the method comprising the steps of creating a text message by said sending party in a first portable digital phone, creating a plurality of optional response messages associated with said text message (col 7 lines 64-67, col 8 lines 1-5), and forwarding said text message with said optional response messages to said receiving party via said SMS channel (col 6 lines 25-30, col lines 5-35).

Regarding **claims 3, 13**, Coad teaches a method wherein one of said optional response messages includes a call-back number allowing a response entered by said receiving party to be transmitted back to said sending party (col 5 lines 5-23).

Regarding **claim 4**, Coad teaches a text Messaging system wherein the response . messages are stored in the memory of the second phone (col 7 lines 30-37).

Art Unit: 2686

Regarding **claim 5**, Coad teaches a method for exchanging a message using a short message service (SMS) (col 6 lines 29-37) between a sending party and a receiving party (col 5 lines 5-19), the method comprising the steps of:

detecting a message having a plurality of optional response messages stored in portable digital phone of the receiving party (col 4 lines 36-38, col 7 lines 64-67, col 8 lines 1-5), the plurality of optional response message is selectively provided by the sending party (col 4 lines 41-44);

selecting one of said optional response messages by said receiving party, forwarding said selected optional response message back to said sending party via said SMS channel (col 6 lines 25-30, lines 5-35);

a text Messaging system wherein the response messages are stored in the memory of the second phone (col 7 lines 30-34), and the plurality of optional response message is selectively provided by the sending party (col 7 lines 25-30).

Regarding **claim 6**, Coad teaches a method of wherein said optional response messages comprise a plurality of items identifying different messages to be selected by said receiving party (col 8 lines 61-67, col 9 lines 1-14, lines 32-38). The call back telephone number itself is display in the form of alphabetic text, for example the text "FOOD" would be converted by the decoder into the digits 3663. Other symbol such as an automobile, travel information, a movie and theater information.

Art Unit: 2686

Regarding **claim 7**, Coad teaches a method wherein the optional message are transmitted to the receiving party by the sending party (col 7 lines 65-66).

Regarding **claim 8**, Coad teaches a method wherein the optional message include a call-back number allowing the selected response entered by the receiving party to be transmitted back to the sending party (col 7 lines 54-66, col 8 lines 1-5).

Regarding **claim 10**, Coad teaches a method wherein the step of storing the text message and the optional response messages in the second terminal upon the text message from the sending party via the SMS channel. (col 6 lines 19-37, col 7 lines 64-67, col 8 lines 1-5).

Regarding **claim 11**, Coad teaches a method further comprising the step of retrieving the text message and the optional messages for a provision to the receiving party (col 8 lines 29-35).

Regarding **claim 12**, Coad teaches a method further comprising the step of displaying the retrieved message in a display unit of the second digital terminal (col 7 lines 50-67, col 8 lines 1-9).

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2686

**Conclusion**

**5. Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications indented for entry)

**Or:**

(703) 308-6306, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II. 2121


Crystal Drive, Arlington. Va., sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

If attempt to reach the examiner are unsuccessful the examiner's supervisor, Marsha Banks-Harold be reached (703) 305-4379.

NM

May 5, 2004

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**